

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 8, 2004 (the "Office Action"). At the time of the Office Action, Claims 1-9, 13-22, 26-30, 31-39, 45-52, 56-60, 61-69, 73-82, 95-96 and 98-102 were pending in the Application. The Office Action rejects Claims 1-9, 13-22, 26-30, 31-39, 45-52, 56-60, 61-69, 73-82, 95-96 and 98-102. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

(e) ✓ | Claims 1-9, 13-22, 26-30, 31-39, 45-52, 56-60, 61-69, 73-82, 95-96 and 98-102 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0055351 by Elsey et al. ("Elsey"). Applicants respectfully traverse these rejections.

35 U.S.C. § 102(e) indicates that a person shall be entitled to a patent unless "the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent . . ." A reference's § 102(e) date that did not result from, nor claim the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. §§ 119(e) or 120 if the prior application(s) properly support the subject matter used to make the rejection. *See* M.P.E.P. § 706.02(f)(1).

The Office Action relies on *Elsey* to support the rejection of all pending claims under § 102(e). *Elsey* was filed on May 25, 2001 and is a non-provisional that claims the benefit of U.S. Provisional Application No. 60/257,913 filed on December 21, 2000 (the "'913 Provisional Application"). *See Elsey*, Related U.S. Application Data and page 1, paragraph 0001. *Elsey* is also a continuation-in-part (CIP) of U.S. Application Serial No. 09/441,656 filed on November 21, 1999 (the "'656 Application"). *See id.*

The present Application was filed on October 25, 2000. Since the filing date of the present Application precedes the filing date of *Elsey* and the '913 Provisional Application of which *Elsey* claims the benefit, a § 102(e) rejection of the present Application based on *Elsey* must rely on the November 21, 1999 date of the '656 Application of which *Elsey* is a CIP. As a

result, the '656 Application must properly support the subject matter of *Elsey* used to make the § 102(e) rejection. *See* M.P.E.P. § 706.02(f)(1).

Applicants have obtained a copy of the '656 Application under 37 C.F.R. § 1.14(a)(1)(v), and it is attached hereto as Exhibit A. The '656 Application relates to providing subscribers of telecommunications services access to directory information in their own individual or group private directories. *See* '656 Application, page 1, lines 10-12. In particular, the '656 Application is directed to providing a calling party the ability to create, administer, modify, and ultimately access, individual or group private directories. *See id.*, page 2, lines 25-27.

Applicants respectfully submit that the '656 Application does not properly support all of the subject matter of *Elsey* used to reject Claims 1-9, 13-22, 26-30, 31-39, 45-52, 56-60, 61-69, 73-82, 95-96 and 98-102. For example, the Office Action relies on "page 14, column 2, section 0124, lines 1-4" of *Elsey* in rejecting Claim 1. *See* Office Action, page 2. This cited portion of *Elsey* states "[i]n addition, a user may specify in a profile his/her preferred types of events and areas of interest, e.g., selected music, fashion and sports events, for which the user would like to receive information from time to time." *Elsey*, paragraph 0124, lines 1-4. The '656 Application contains no disclosure regarding user-specified preferred types of events (e.g., selected music, fashion and sports events) for which the user would like to receive information. As an additional example, the Office Action also relies on the disclosure of "directions to various places" and "sending invitations" as provided services in paragraph 0038 of *Elsey* in rejecting Claim 1. *See* Office Action, pages 2-3. The '656 Application contains no disclosure regarding the provision of these services. The Office Action relies on the same portions of *Elsey* discussed above with the rejection of Claim 1 in rejecting Claims 31, 61 and 95. *See* Office Action, pages 7-8. Therefore, the '656 Application does not properly support the subject matter of *Elsey* used to reject Claims 1, 31, 61 and 95, and Applicants thus respectfully request that the rejections of Claim 1, 31, 61 and 95 be withdrawn.

Claims 2-9, 13-22 and 26-30 each depends, either directly or indirectly, from Claim 1; Claims 32-39, 45-52, 56-60 each depends, either directly or indirectly, from Claim 31; Claims 62-69 and 73-82 each depends, either directly or indirectly, from Claim 61; and Claims 96 and

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98-102 each depends, either directly or indirectly, from Claim 95. Thus, for at least the reasons discussed above with respect to Claims 1, 31, 61 and 95, Applicants respectfully request that the rejections of Claims 2-9, 13-22, 26-30, 32-39, 45-52, 56-60, 62-69, 73-82, 96 and 98-102 be withdrawn. Applicants additionally note that other portions of *Elsey* relied upon in the Office Action's rejections are also not supported in the '656 Application.

CONCLUSIONS

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

Although no fees are believed to be currently due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTTS L.L.P.

Respectfully submitted,

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Enclosure: Exhibit A - Copy of U.S. Patent Application Serial No. 09/441,656